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Mailed: October 21, 2021

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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BandGrip, Inc.

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Application Serial No. 88265665

Jovan N. Jovanovic and Samantha Stumpo of The Watson IP Group, PLC,
for BandGrip, Inc.

Shaila E. Lewis, Trademark Examining Attorney, Law Office 114,
Laurie Kaufman, Managing Attorney.

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Before Zervas, Bergsman, and Goodman,
Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

BandGrip, Inc. (“Applicant”) seeks registration on the Principal Register of the mark SMART SUTURE (in standard characters) for “bandages for surgical use for skin wounds having mechanical hooks that penetrate the skin on either side of the wound for attachment to the skin,” in International Class 5.¹

The Examining Attorney refused to register Applicant’s mark on two grounds:

¹ Application Serial No. 88265665 was filed on January 17, 2019, under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based upon Applicant’s claim of a bona fide intention to use the mark in commerce.

- Applicant’s mark is merely descriptive under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1); and, in the alternative,
- Applicant’s mark consists of or includes deceptive matter in relation to the description of goods under Section 2(a) of the Trademark Act, 15 U.S.C. § 1052(a).

Citations to the prosecution history are to the Trademark Status and Document Retrieval (TSDR) system by page number in the downloadable .pdf format.

I. Preliminary Issue

Before proceeding to the merits of the refusal, we address two evidentiary matters. First, during the prosecution of the application, the Examining Attorney submitted the same evidence multiple times. For example, the Examining Attorney submitted the dictionary definition of “suture” from the same source twice² and the definition of “smart” from the same source four times.³ Suffice it to say, the probative value of evidence does not become more probative with repetition.

Second, the Examining Attorney submitted several exhibits with “pop-ups” posted across the document interfering with the legibility and, thus, the probative value of the evidence.⁴ We reproduce below a representative example:⁵

² April 5, 2019 Office Action TSDR (4-6); July 6, 2020 Office Action (TSDR 13-17).

³ April 5, 2019 Office Action (TSDR 8-10); November 6, 2019 Office Action (TSDR 57-63); July 6, 2020 Office Action (TSDR 6-12); February 9, 2021 Office Action (TSDR 34-45).

⁴ See *e.g.*, November 6, 2019 Office Action (TSDR 22, 29-31, 39-41, and 47-49).

⁵ *Id.* at TSDR 29.

Smart sutures coated with sensors help wounds heal

Researchers have covered plastic and silk threads with temperature sensors and micro-heaters that monitor the wounds and speed up healing.

By Janet Fang | August 27, 2012 – 11:20 GMT (04:20 PDT) | Topic: Innovation

The image is a screenshot of a news article snippet. At the top, there is a banner for the American Red Cross with the text "Support the American Red Cross." and a "CLICK HERE" button. Below this is a social media navigation bar with icons for Facebook, LinkedIn, Twitter, and Email. On the left, there is a red box with the text "Interested in Innovation?" and "Subscribe to our Innovation Weekly newsletter", followed by an "Email Address" input field and a red "SIGN UP" button. In the center, there is a diagram of a suture with labels: "Top: Si diode Temp. Sensor", "Polyester fabric strip coated with PDMS", and "Bottom: Au micro-heater". On the right, there is a small image of a person looking at a screen with the text "Rescue by LogMeIn".

The Examining Attorney is responsible for ensuring the documents she submits are legible. *See In re Virtual Independent Paralegals, LLC*, 2019 USPQ2d 111512, at *7 n.23 (TTAB 2019) (“[T]he Board will consider evidence, or a portion of the evidence, only if it is clear and legible.”); *In re Loggerhead Tools, LLC*, 119 USPQ2d 1429, 1433 n.5 (TTAB 2016) (filers are responsible for ensuring that all submissions are legible). We will consider evidence only if it is clear and legible.

II. Is SMART SUTURE deceptive under Section 2(a) of the Trademark Act?

Section 2(a) of the Trademark Act, 15 U.S.C. § 1052(a), bars registration of a mark that “consists of or comprises ... deceptive ... matter.” The USPTO cannot register a deceptive mark on the Principal or Supplemental Register, 15 U.S.C. § 1091, and neither a claim of acquired distinctiveness nor a disclaimer of the deceptive matter renders it registrable. *In re White Jasmine LLC*, 106 USPQ2d 1385, 1391 (TTAB 2013).

A mark may be deceptive even if only a portion of the mark is deceptive. *See Am. Speech-Language-Hearing Assoc. v. Nat’l Hearing Aid Soc’y*, 224 USPQ 798, 808

(TTAB 1984). “It is well established that a mark may be found deceptive on the basis of a single deceptive term that is embedded in a larger mark.” *White Jasmine*, 106 USPQ2d at 1391 .

We determine whether a mark is deceptive based on the description of goods. “Registrability of a mark is always considered in conjunction with the identified goods or services, for an applicant cannot obtain rights in a mark in the abstract, only in connection with specified goods or services.” *In re ALP of S. Beach Inc.*, 79 USPQ2d 1009, 1019 (TTAB 2006); *see also Roselux Chem. Inc. v. Parson’s Ammonia Co., Inc.*, 299 F.2d 855, 132 USPQ 627, 632 (CCPA 1962) (whether a term or mark is merely descriptive must be decided in relation to the goods for which registration is sought and the impact that it is likely to make on the average purchaser of those goods).

We must refuse to register a mark a proposed mark as deceptive if:

(1) it consists of or comprises a term that misdescribes the character, quality, function, composition, or use of the goods;

(2) prospective purchasers are likely to believe that the misdescription actually describes the goods; and

(3) the misdescription is likely to affect the purchasing decision of a significant or substantial portion of relevant consumers.

In re Budge Mfg. Co., 857 F.2d 773, 8 USPQ2d 1259, 1260 (Fed. Cir. 1988); *see also In re Tapco Int’l Corp.*, 122 USPQ2d 1369, 1371 (TTAB 2017); *cf. In re Miracle Tuesday, LLC*, 695 F.3d 1339, 104 USPQ2d 1330, 1334 (Fed. Cir. 2012) (the test for

materiality incorporates a requirement that a significant portion of the relevant consumers be deceived).

A. Relevant Facts

The AMERICAN HERITAGE DICTIONARY OF THE ENGLISH LANGUAGE (5th ed. 2016) defines “suture” as, *inter alia*, “the fine thread or other material used surgically to close a wound or join tissues or the stitch so formed.”⁶

The MERRIAM-WEBSTER DICTIONARY (merriam-webster.com) defines “bandage” as follows:⁷

- 1 : a strip of fabric used especially to cover, dress, and bind up wounds
- 2 : a flexible strip or band used to cover, strengthen, or compress something

Merriam-Webster.com identifies “bind,” “dress,” and “swathe” as synonyms for bandage.

⁶ YourDictionary.com attached to the April 5, 2019 Office Action (TSDR 5). *See also* WEBSTER’S NEW WORLD COLLEGE DICTIONARY (2013) posted on YourDictionary.com attached to the April 5, 2019 Office Action (TSDR 4) (“the act of joining together the two edges of a wound or incision by stitching or similar ways.”); AMERICAN HERITAGE DICTIONARY OF MEDICINE (2018) posted on Dictionary.com attached to the April 5, 2019 Office Action (TSDR 6) (“the fine thread or other material used surgically to close a wound or join tissue” and “the process of joining two surfaces or edges together along a line by sewing”).

⁷ The Board may take judicial notice of dictionary definitions, including online dictionaries that exist in printed format. *In re Cordua Rests. LP*, 110 USPQ2d 1227, 1229 n.4 (TTAB 2014), *aff’d*, 823 F.3d 594, 118 USPQ2d 1632 (Fed. Cir. 2016); *In re S. Malhotra & Co. AG*, 128 USPQ2d 1100, 1104 n.9 (TTAB 2018); *In re Red Bull GmbH*, 78 USPQ2d 1375, 1378 (TTAB 2006). We take judicial notice of this definition of “bandage.”

In her February 9, 2021 Office Action (TSDR 52-55), the Examining Attorney submitted a definition of “bandage” posted on YourDictionary.com. However, the exhibit did not display the source from which YourDictionary.com derived the definition. We take judicial notice of “bandage” from the MERRIAM-WEBSTER DICTIONARY to ensure the accuracy of the definition.

The evidence of record establishes that sutures and bandages are separate and distinct products. With the exception of an article posted on the Healthline website (healthline.com)⁸ and Applicant's website, discussed below, there is no evidence that anyone uses sutures to refer to bandages or vice versa. The following exhibits are representative of evidence of record:

- Science News for Students website (sciencenewsforstudents.com)

'Smart' sutures monitor healing (August 29, 2016)

Simple threads turned into sensors can relay what's going on under a bulky bandage⁹

Sutures are threads used to close up a wound. They are pretty low tech. In many case, they're made of natural materials such as cotton or silk. In others, they're made from a form of plastic. ... Regardless of what they're made from, however, their purpose is the same. They hold large wounds or incisions together so they can heal.

... So [Sameer Sonkusale, an electrical engineer at Tufts University] figured out a way to transform sutures into sensors. These special stitches can report what's going on beneath a bandage. They can even send out health dispatches from inside the body.¹⁰

The key to making a suture "smart," says Sonkusale, is allowing it to conduct electricity, Thread alone won't normally do that. So, researchers coated a cotton thread with a conducting material. Some coatings can sense the stretching of the tissue. This might indicate swelling. In other cases, the coatings can measure the pH, or acidity, of

⁸ July 6, 2020 Office Action (TSDR 61) ("Butterfly stitches, also known as Steri-Strips or butterfly bandages, are narrow adhesive bandages that are used instead of traditional stitches (sutures) to close small, shall cuts.")

⁹ November 6, 2019 Office Action (TSDR 9).

¹⁰ *Id.* at TSDR 10.

the tissue they pass through. Changes in pH might indicate an infection is developing. The team sometimes added small sensors in the thread to measure body temperature. They detect when a wound warms up, signaling a brewing infection.¹¹

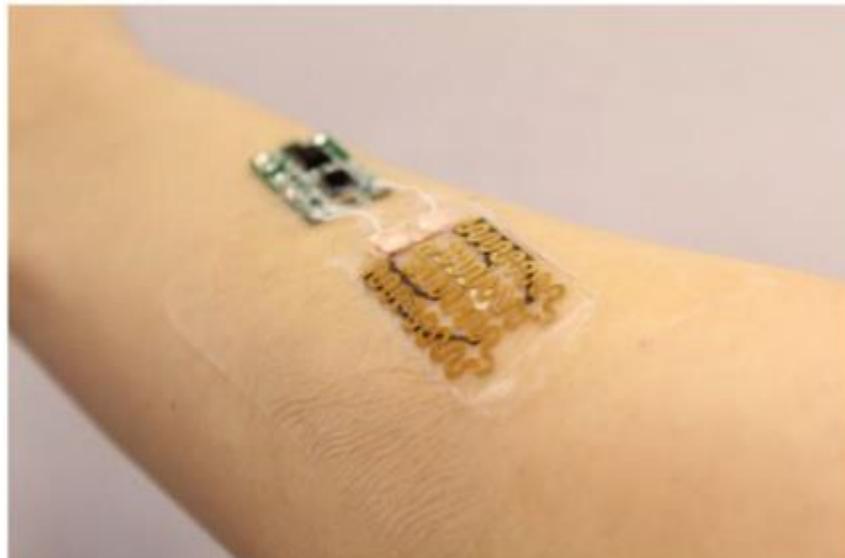
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Suture A stitch or row of stitches holding together the edges of a wound or surgical incision.¹²

- TuftsNow website (now.tufts.edu)

Smart bandages designed to monitor and tailor treatment for chronic wounds (November 6, 2019)

Bandages with integrated pH and temperature sensors and electronically triggered drug release are designed to improve healing.¹³



A smart bandage with wound covering component (right), containing sensors and a drug carrier, and microprocessor (left) that interprets sensor input and triggers drug delivery.

¹¹ *Id.* at TSDR 11.

¹² *Id.* at TSDR 14.

¹³ *Id.* at TSDR 46.

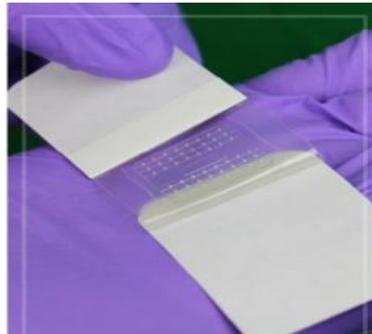
[R]esearchers designed the bandages with heating elements and thermoresponsive drug carriers that can deliver tailored treatments in response to embedded pH and temperature sensors that track infection and inflammation.¹⁴ (TSDR 47)

Applicant's website <bandgrip.com> refers to a bandage as a suture when it advertises its BandGrip as "the telemedicine suture."¹⁵ Despite that statement, Applicant distinguishes its product from a suture.

Unlike the raised surfaces of staples and zippers, and the "whiskers" associated with sutures, the smooth surface of BandGrip Micro-Anchor Skin Closures doesn't catch on dressings or clothing. ...

Our patented, minimally invasive BandGrip Micro-Anchor Closures gently and securely grip the skin to close the wound edges during the critical healing process.¹⁶

We reproduce below a photograph of Applicant's product.¹⁷



¹⁴ *Id.* at TSDR 47.

¹⁵ February 9, 2021 Office Action (TSDR 47).

¹⁶ February 9, 2021 Office Action (TSDR 49).

¹⁷ *Id.*

In addition, Applicant compares its BANDGRIP product to sutures.¹⁸ Thus, Applicant's product is "a strip of fabric used especially to cover, dress, and bind up wounds," not "the fine thread or other material used surgically to close a wound or join tissue."

B. Does SMART SUTURE consist of or contain a misdescription of the goods?

Applicant is seeking to register SMART SUTURE to identify "bandages for surgical use for skin wounds having mechanical hooks that penetrate the skin on either side of the wound for attachment to the skin." A "suture" is not a "bandage." Therefore, Applicant's mark SMART SUTURE consists of or contains a misdescription of the goods.

We note that the Examining contends that sutures encompass bandages "because there is no specific material used for bandages, and, like sutures, they can join together the two edges of a wound or incision."¹⁹ However, the evidence discussed above demonstrates that sutures and bandages are two distinct products that serve a similar purpose. They are not identical products.

We also note that the Examining Attorney contends that Applicant's mark SMART SUTURE is deceptive because "consumers are likely to believe applicant's goods are sutures programmed with features that make them perform better in some way."²⁰

¹⁸ *Id.* at TSDR 51.

¹⁹ Examining Attorney's Brief (8 TTABVUE 6 and 12).

²⁰ *Id.* at 15.

However, we need not find that the Examining Attorney’s rationale is correct to affirm the refusal to register, but rather may rely on a different rationale. TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE § 1217 (2021). *See also In re AFG Industries Inc.*, 17 USPQ2d 1162, 1163 (TTAB 1990) (“[W]e note that the Board reviews an Examining Attorney’s decision on appeal to determine if the refusal to register was correctly made. In doing so, the Board need not adopt the rationale of the Examining Attorney.”); *In re Avocet, Inc.*, 227 USPQ 566, 567 (TTAB 1985) (“[T]he Trademark Trial and Appeal Board, when exercising its appellate jurisdiction under Section 20 of the Lanham Act (15 USC §1070), reviews the ‘decision’ of the Examining Attorney for its correctness and need not adopt the Examining Attorney’s rationale in every respect in order to affirm the decision of the Examining Attorney.”).

C. Is the “suture” misdescription believable?

Sutures and bandages serve a similar purpose (i.e., to close a wound) and may be used together. *See e.g.*,

- Advanced Tissue website (advancedtissue.com)

What is a smart bandage? (September 17, 2018)

You should cover your wound with a bandage – that much you know for sure but are you following your doctor’s orders to properly care for your skin injury and prevent infections?²¹

- Science News for Students website (sciencenewsforstudents.com)

‘Smart’ sutures monitor healing (August 29, 2016)

²¹ *Id.* at TSDR 5.

After a doctor stitches up a gash or other cut, the wound usually gets a bandage. ...

Sutures are the threads used to close up a wound. ...

... So he and his teammates figured out a way to transform sutures into sensors. These special stitches can report what is going on beneath a bandage.²²

- Nebraska Today website (news.unl.edu)

Smart bandage could promote better, faster healing (October 5, 2017)

Existing bandages range from dry patches to more advanced designs that can passively release an embedded medication over time.²³

- Digital Trends website (digitaltrends.com)

Ingenious bandage seals up wounds without stitches, promotes scar-free healing (June 29, 2017)

If you've ever received an open wound that requires closing up with a bit more vigor than a regular bandage, you may have come across butterfly closures. These adhesive bandage strips can be used to close small wounds by pulling the skin on either side of the skin break together, and then holding them in place. Their big advantage over stitches is the fact that they're easier to care for and lessen the risk of scarring.²⁴

²² *Id.* at TSDR 9-10.

²³ *Id.* at TSDR 50-53.

²⁴ July 6, 2020 Office Action (TSDR 19).

- Healthline website (healthline.com)

How to Apply and Remove Butterfly Stitches

Butterfly stitches, also known as Steri-Strips or butterfly bandages, are narrow adhesive bandages that are used instead of stitches (sutures) to close small, shallow cuts.²⁵

Because doctors, nurses and other caregivers use both sutures and bandages for wound care and they may use them together, Applicant's use of "sutures" in its mark is not only false but is believable and would mislead consumers into thinking that the goods associated with the mark are sutures.

We find that doctors, nurses and other caregivers would believe that goods bearing the mark SMART SUTURE are sutures rather than bandages, satisfying the second prong of the deceptiveness test. *See, e.g., In re E5 LLC*, 103 USPQ2d 1578, 1583 (TTAB 2012) ("We find that, because the evidence shows that copper is a common supplement or ingredient in dietary supplements, consumers will believe, based on the mark [ALPHA CU] and the goods at issue, that applicant's goods contain copper. Thus, the second prong of the Section 2(a) deceptiveness test has also been satisfied."); *In re Tapco Int'l Corp.*, 122 USPQ2d 1369, 1373 (TTAB 2017) (evidence that "some adhesives are, in fact, clear and that this feature is touted to consumers" sufficient to satisfy burden that proposed mark KLEER ADHESIVES satisfied second element of deceptiveness test).

²⁵ *Id.* at TSDR 61.

D. Is the misdescription material to the purchasing decision?

We turn next to the third prong of the deceptiveness test, whether the misdescription is likely to affect the purchasing decision of a significant portion of relevant consumers. Thus, we assess whether prospective purchasers consider sutures a necessary or desirable product. *See In re White Jasmine LLC*, 106 USPQ2d 1385, 1392 (TTAB 2013) (citing *In re Juleigh Jeans Sportswear Inc.*, 24 USPQ2d 1694, 1698-99 (TTAB 1992)).

The record in its entirety convinces us that the type of material used bind or close wounds is material to the purchasing decision of a significant portion of the relevant consumers. The record lacks direct evidence of the consumer perception of the mark and motivation in purchasing. Nonetheless, “indirect evidence of materiality is permitted, and an inference of materiality may be made....” *In re Les Halles de Paris J.V.*, 334 F.3d 1371, 67 USPQ2d 1539, 1542 (Fed. Cir. 2003) (discussing materiality in the context of Section 2(e)(3) geographic misdescriptiveness). Here, the record strongly reflects the nature of the wound determines whether to use sutures or bandages, and makes such an inference appropriate. The evidence as a whole shows that consumers are motivated to purchase or use sutures in particular, at least in part because doctors, nurses and other caregivers out of habit, need, and training use sutures.²⁶

²⁶ Applicant’s website attached to the February 9, 2021 Office Action (TSDR 51).

E. Conclusion as to deceptiveness

Having determined that the Examining Attorney has met each of the three elements of the deceptiveness test, we find that the refusal to register SMART SUTURE for Applicant's identified bandages is appropriate and therefore affirm it.

Because we affirm the deceptiveness refusal, we need not analyze the descriptiveness refusal under Section 2(e)(1) of the Trademark Act. *See In re DTI P'ship LLP*, 67 USPQ2d 1699, 1702 (TTAB 2003) (affirmance of requirement for product information was sufficient basis to refuse registration; Board declined to reach merits of refusal based on mere descriptiveness because applicant's failure to submit required information hindered Board's ability to assess the latter refusal). "Like the federal courts, the Board has generally used its discretion to decide only those claims necessary to enter judgment and dispose of the case. . . [T]he Board's determination of registrability does not require, in every instance, decision on every pleaded claim." *Multisorb Tech., Inc. v. Pactiv Corp.*, 109 USPQ2d 1170, 1171 (TTAB 2013).

Decision: We affirm the refusal to register Applicant's mark SMART SUTURE under Section 2(a) of the Trademark Act.